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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/000,924	12/30/97	HASEBE T	1083.1048/JD

LM02/0314

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WASHINGTON DC 20001

EXAMINER	
NGUYEN, C	
ART UNIT	**PAPER NUMBER**
2764	6

DATE MAILED: 03/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/000,924	Hasebe et al.
Examiner	**Group Art Unit**
Cuong H. Nguyen	2764

☒ Responsive to communication(s) filed on *Jan 3, 2000*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-21* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-21* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. This Office Action is the answer to the amendment received on 1/03/2000.

2. Claims **1-21** are pending in this application. Claims 18-21 are added.

3. Applicant's arguments received on 1/03/2000 have been fully considered but they are not persuasive with cited arts.

Therefore, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. The examiner submits that the reasons for rejection are obvious (v.s. cited prior arts) with claim language (on 35 U.S.C. 103 rejections). Applicants are suggested to indicate **in the claims how** the claims distinguish from the combining of cited prior arts.

A. Applicant's arguments do not comply with 37 CFR 1.111© because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. (E.g. the previously cited **US Pat. 5,761,651**, Hasebe et al. disclose (see **'651** 12:61-64): "*14. The software charging system according to claim 12, wherein utilization prices subtracted from the credit at each utilization are ciphered together with said utilization key by said secret keys and added to the software program.*", and "*However, as this kind of software is still very expensive, more often than not the end users hesitate to buy such software until they can make sure that it really is what they want or that it can be used for the hardware they own. Against such a background, new software distributing systems have started to be provided, wherein a number of software with functional limits attached are sold*

inexpensively stored in CD-ROM. When the end users select the ones they want from such software and send fees, codes for releasing the functional limits will be reported to them." (See '651 1:36-45), and in '651 12:38-57 "*12. A software charging system comprising:*

an authorization center setting a utilization amount;

a utilization permitting device including a utilization amount managing part calculating a balance of the utilization amount set by the authorization center, and a utilization permission processing part permitting utilization of protected software in accordance with the balance calculated by the utilization amount managing part, wherein, said utilization permitting device includes utilization key data storing means for storing utilization key data necessary to permit software program utilization, said utilization amount managing part includes credit balance storing means shared by a plurality of software programs, and a plurality of groups of secret key storing means for storing secret keys, and said utilization key is ciphered by said secret keys and added to said software program.", and in the cited US Pat. 5,832,083 Iwayama et al. disclose: "*Giving consideration to the reasons (1) to (3) mentioned above, the manufacturers have been selling CD-ROMs storing a plurality of pieces of*

software with functional limits attached. By actually using the software with functional limits attached, the end users in turn are allowed to identify if it is really what they desire. When they find that the used software is the one they require, the end users will pay normal fees. The manufacturers will report to the end users codes for releasing the functional limits of the software. Then, the end users will release the limits by using the codes given by the manufacturers. In this way, the end users will be allowed to utilize all the functions of the software" (see **'083** 1:45-56), and "*The key generating section 1b generates a key decoding key using information converting section identification information for identifying the information converting section 1 attached to each reproducing device. This key generating section 1b includes a key registering section 10 for storing specified key information and a converting section 11 for converting information converting section identification information by key information stored in this key registering section 10 and generating a key decoding key.*" (See **'083** 8:41-54). In these disclosures, the function of appending/adding/attaching information/data and permission are obviously suggested.

B. Also, in response to applicant's arguments, in some claims, the recitation of "A data protection system for protecting data requiring authorization for use against unauthorized use during data utilization" has not been given patentable weight because this recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the

purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

C. The examiner submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

5. Claims **1-5, 9, 12, 15, 18-21** are rejected under 35 U.S.C. § 103 as being unpatentable over Hasebe et al. (US Pat. 5,392,351), in view of Hasebe et al. (US Pat. 5,761,651), further in view of Hasebe et al. (US Pat. 5,832,083).

A. Referring to claim **1**: The claim is directed to a data protection system, comprising:

- means for storing data (this limitation is in claims 4, 9, 15, and they are very obvious with cited prior arts; see at least Hasebe et al. '351 claim 8);

- storage means for storing data (this limitation is in claims 1,4, 9; see at least Hasebe et al. '651 Figs. 1, 5 ref.303 for obviousness);

- working/preparing means with input data (this limitation is in claims 1, 4, 9, 12, 15, it comprises a different/broad term for actions comprising: preparing, generating, appending, displaying data .etc. and they are very obvious with cited prior arts, see at least Hasebe et al. '351 3:47-56 for obviousness);

- means for generating information relating to input data (which is to be utilized in prepared data) (e.g. judging means, this limitation is in claims 1, 9, 12; see at least Hasebe et al. '651 6:8-17, 50-65; see also Hasebe et al. '083 Fig.10 (refs. 1009, 1010), Fig.16 (refs. 1607, 1608), & Figs. 18-19 for obviousness);

- comparing/judging means if using input data (this limitation is in claims 1, 4, 9 - see Hasebe et al. '651 6:8-17, 50-65, Figs. 8-9; see also Hasebe et al. '083 Figs. 4 (ref. 2), 7, 8(ref.2a), 13-14, 16);

- means for updating/appending/adding generated information to prepared data (this limitation is in claims 1, 12)(see at least Hasebe et al. '651 claim 12 for obviousness);

- means for displaying (prepared)/input data (this limitation is in claims 1, 12); (see at least Hasebe et al. '083

Figs.4(ref.5), 5; Fig.20 (refs.2014, 2016); see also Hasebe et al. '651 Fig.2 for obviousness); and

Hasebe et al. do not specifically teach about means for forbidding saving (input) data. (this limitation is in claims 1,4, 9);

However, the examiner submits that this limitation is well-known in the art; e.g. a decision-making query/instruction for a similar task ("not saving data if ...): because it is simply an optional query/instruction that it would be recognized as useful to put in a computerized system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a system for combining the teaching references to apply above limitation in the disclosure of Hasebe et al., because this would increase extra flexible options for a data protection system.

B. Referring to claims **4, 9, 12, 15, 18-21**: The limitations of these claims recite similar claims' limitations (of fewer limitations) as claim 1 discussed above. The same analysis and reasoning set forth above in the rejection of claim 1 applied to these claims also because they cover a similar method/system/device that doing same steps with similar means as the above system.

C. Referring to claim **2**: Claim 2 is directed to a data protection system, further comprising:

means for executing cut & paste; and

means for forbidding cut & paste (data).

The rationales for rejection of claim 1 are incorporated.

The examiner submits that these 2 limitations are very obvious & well-known because they would present a well-known feature (as options) to one with skills in the art.

D. Per claims **3, 5:**

The rationales for rejection of claim 1 are incorporated.

D1. Referring to claim **3**: This claim is directed to a data protection system with means for judging (input) data is encrypted data; and means for determining allowed/permitted data (see also Hasebe et al. '651 3:46-54 for obviousness).

The examiner submits that limitations for this claim are already discussed in claim 1 above. The rationales for rejection are similar.

D2. Referring to claim **5**: The limitations of this claim recite the same claim's limitations (of fewer limitations) as claim 3 discussed above. The same analysis and reasoning set forth above in the rejection of claim 3 applied to theses claims also because it covers similar limitations as the above system.

E. Referring to claim **6**: This claim is dependent of claim 4, a limitation is a difference between original data to be worked and the data after. The rationales for rejection of claim 4 are incorporated. This limitation is obvious since it is an option to distinguish between old and new data with comparison means; see also Hasebe et al. '651 5:32-35 for obviousness).

F. Referring to claim **7**: It is directed to a data protection system, comprising:

means for displaying (original) data, and updated data.

The rationales for rejection of this claim is similar as in claim 1/4.

6. Claims **10-11** are directed to a data protection system, comprising limitations that rationales for rejection of claims 1/9 are incorporated:

A. Re. Claim 10: A limitation is means for distributing data (see at least Hasebe et al.'083 Figs. 14, 19 (ref.1910), and 20 (ref. 2014) for obviousness);

B. Re. Claim 11: A limitation is means for distributing (update) data (see at least Hasebe et al.'083 Fig. 21 for obviousness).

7. Referring to claim **8**: The limitation in this claim is quite obvious with one of skills in the art to add an option as storage means includes means for adding information (The rationales for

rejection of claims 1/4 are incorporated; then see at least Hasebe et al. '651 claim 12).

8. Referring to claims **13, 16**:

A. Per claim 13: The limitations in these claim are quite obvious with one of skills in the art:

judging (yes or no) (there is a license for utilizing data. (same claim's limitation as #1.f, and #9) ; and

means for permitting/allowing input data to be displayed. (same claim's limitation as in claim #1).

The same rationales for rejection of claims 1/13/15 is used herein.

B. Referring to claim **16**:

The limitations of this claim recite the same claim limitations as claim 13 above. The same analysis and reasoning set forth in the rejection of claim 13 applied to this claim also because it covers a device that having similar means.

9. Referring to claim **14**: The limitation in this claim (#14) is obvious and well-known with one of skills in the art: The data preparation device/protection system wherein the balance of the charge is used as the license (because it is still less than a maximum balance available; with rationales for rejections of claims 1/12 are incorporated).

10. Referring to claim **17**: The limitation of this claim recite the same claim's limitation as claim 14 discussed above. The same analysis and reasoning set forth above in the rejection of claim 14 applied to this claim also because it covers a device that including similar means.

Conclusion

11. Claims **1-21** are rejected.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

Any response to this action should be mailed to:

Box Issue Fee Amendments

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c/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuong H. Nguyen
March 09, 2000

James P. Trammell
Supervisory Patent Examiner
Technology Center 2700